

02-02-06

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PTO/SB/21 (09-04)

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<h1>TRANSMITTAL FORM</h1> <p><i>(to be used for all correspondence after initial filing)</i></p>	Application Number	10/807,789-Conf. #4254	
	Filing Date	March 24, 2004	
	First Named Inventor	Robert A. Greene	
	Art Unit	2814	
	Examiner Name	L. Pham	
Total Number of Pages in This Submission	8	Attorney Docket Number	49581/P042US/10315832

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Date	February 1, 2006	Reg. No.	44,034



Docket No.: 49581/P042US/10315832
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Robert A. Greene

Application No.: 10/807,789

Confirmation No.: 4254

Filed: March 24, 2004

Art Unit: 2814

For: SYSTEM AND METHOD FOR COUPLING
INTERNAL CIRCUITRY OF AN
INTEGRATED CIRCUIT TO THE
INTEGRATED CIRCUIT'S PACKAGE PINS

Examiner: L. Pham

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 CFR §1.144

Director for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.144, Applicant respectfully petitions the Director to reconsider and withdraw the Restriction Requirement raised in the Office Action mailed December 13, 2005 for the above-identified patent application.

Statement of Facts

The present patent application was filed March 24, 2004 with 44 claims, numbered 1-44. A Restriction Requirement was mailed August 29, 2005 requiring election as between:

Group 1: Claims 18-31, drawn to a semiconductor process, classified in class 438, subclass 106; and

Group 2: Claims 1-17 and 32-44, drawn to a semiconductor device, classified in class 257, subclass 724.

The Restriction Requirement asserted that the claims of Group 1 and Group 2 are related as a process of making and product made.

The Restriction Requirement also required election of one of the following species:

Specie 1: embodiment of FIGURE 1, and

Specie 2: embodiment of FIGURE 4.

Applicant traversed the above Restriction Requirement and requested reconsideration pursuant to 37 C.F.R. § 1.143 in a Response submitted September 29, 2005, which provisionally elected the claims of Group 2 (claims 1-17 and 32-44) and Specie 1 (embodiment of FIGURE 1) for continued examination.

However, an Office Action was then mailed December 13, 2005, which modified the restriction requirement to include claim 14 in Group 1, rather than in Group 2, and made such modified Restriction Requirement "Final."

Applicant respectfully petitions that the Director reconsider and withdraw both the original Restriction Requirement and the modified Restriction Requirement for the reasons provided in the following remarks.

Remarks

I. Claim Restriction

Improper Finality of Restriction Requirement

Applicant respectfully submits that the Finality of the Restriction Requirement is improper. The Office Action mailed December 13, 2005 modified the restriction originally required in the Restriction Requirement of August 29, 2005 to group claim 14 with claims 18-38. Applicant has not been afforded a full and fair opportunity to respond to the modified restriction requirement, nor has Applicant been afforded an opportunity to elect one of the modified group of claims for examination. Rather, Applicant was required to elect as between (I) claims 18-31 and (II) claims 1-17 and 32-44. Applicant provisionally elected group II (claims 1-17 and 32-44), which included claim 14.

The Examiner has improperly taken it upon himself in the December 13, 2005 Office Action to remove from consideration claim 14 without affording Applicant an opportunity to respond to the modified restriction or to elect from the modified group of claims, which now

appear to be grouped as (I) claims 14 and 18-31 and (II) claims 1-13, 15-17, and 32-44. No reasoning for the new grouping of claims is provided in the December 13, 2005 Office Action except “that claim 38 should be grouped together with claim 14” (*see* page 2 of the Office Action). Such concession by the Examiner that claim 14 was improperly grouped in the August 29, 2005 Restriction Requirement necessarily means that the original restriction as between claims (I) claims 18-31 and (II) claims 1-17 and 32-44 raised in such August 29, 2005 Restriction Requirement was improper, and thus the new requirement presented for the first time in the December 13, 2005 Office Action should not have been made Final.

Both the Original and Modified Restriction Requirements are Improper

Applicant maintains that the original Restriction Requirement raised in the August 29, 2005 Office Action is improper for the reasons set forth in Applicant’s response of September 29, 2005. Further, Applicant maintains that the modified Restriction Requirement presented in the December 13, 2005 Office Action is likewise improper. Thus, in addition to the restriction raised in the December 13, 2005 Office Action being improperly made final, Applicant also submits that for the same reasons presented below as to the original Restriction Requirement, a *prima facie* case for the December 13, 2005 restriction requirement has not been established by the Examiner.

In the August 29, 2005 Restriction Requirement, the Examiner asserts that the claims of Group 1 and Group 2 are related as a process of making and product made. The Examiner further explains that these can be shown to be distinct if either of the following is shown: (1) that the process as claimed can be used to make other and materially different product, or (2) that the product as claimed can be made by another and materially different process. The Examiner concludes that here the product as claimed “can be made by another and materially different process such as one in which the second carrier is coupled to the electrically common interface before the first carrier is coupled to the electrically common interface.” Page 2 of the Office Action.

However, the process of claim 18 does not require that the first and second carriers be coupled in any particular order. Thus, the process of claim 18 reads on the process that the Examiner asserts to be materially different (i.e., a process in which the second carrier is coupled

before the first carrier is coupled). As such, the Examiner has failed to show that the product as claimed can be made by another and materially different process. Therefore, the Examiner has failed to establish a prima facie case for this restriction, and as such the restriction requirement should be withdrawn.

In response to the above arguments, the December 13, 2005 Office Action asserts that “claim 18 clearly requires the first carrier to be coupled to the common interface before the second carrier is coupled to the common interface”. Page 2 of the Office Action. Applicant strenuously disagrees, and submits that the Examiner has incorrectly interpreted the clear language of claim 18. Claim 18 recites:

A method comprising:
coupling a first carrier from an internal resonant frequency circuitry of an integrated circuit to an electrically common interface of the integrated circuit's package, wherein said first carrier is arranged to carry signals of a first polarity;
coupling a second carrier from said internal resonant frequency circuitry of said integrated circuit to said electrically common interface of the integrated circuit's package, wherein said second carrier is arranged to carry signals of a polarity opposite said first polarity; and
coupling a third carrier from said internal resonant frequency circuitry of said integrated circuit to said electrically common interface of the integrated circuit's package, wherein said third carrier is arranged to carry signals of said first polarity.

While three coupling steps are recited in claim 18, no order in which the coupling steps are to be performed is recited. For instance, claim 18 clearly reads on any method that performs the three coupling steps, irrespective of the order in which the three coupling steps are performed. For example, the claim encompasses a method in which the recited third carrier is first coupled, then the second carrier, and then the first carrier. While the coupling of the first carrier is the first recited element of the claim, the claim does not recite that the coupling of the first carrier is necessarily performed before the performance of the later recited coupling steps. For instance, the claim does not recite any indication of an order of the coupling steps, such as “first,” “next,” etc., and thus the Examiner's assertion that claim 18 clearly requires the first carrier to be coupled to the common interface before the second carrier is coupled to the common interface is completely incorrect.

“During patent examination, the pending claims must be ‘given their broadest reasonable interpretation consistent with the specification.’” M.P.E.P. §2111, *quoting In re Hyatt*, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Thus, because the method of claim 18 does not recite any order of the elements, it should not be interpreted as requiring any particular order in the performance of the elements.

Accordingly, the Examiner has failed to show that the product as claimed can be made by another and materially different process. Therefore, the Examiner has failed to establish a prima facie case for this restriction, and as such the restriction requirement should be withdrawn.

In addition, the modified grouping presented in the December 13, 2005 Office Action groups claim 14, which is directed to the “integrated circuit of claim 12” with claims 18-31, which the Restriction Requirement of August 29, 2005 asserts are directed to a process of making a device. Claim 14 is clearly not directed to a process, as with claims 18-31, and therefore Applicant asserts that this modified restriction is nonsensical and should be withdrawn.

II. Specie Restriction

The August 29, 2005 Restriction Requirement also asserted that two distinct species are included in the application. Specifically, the Restriction Requirement identified:

Specie 1: embodiment of FIGURE 1, and

Specie 2: embodiment of FIGURE 4.

The Restriction Requirement also asserted that currently no claim is generic as to these species. Applicant respectfully disagrees with this assertion. For instance, various claims are included that read on both of the identified species. For instance, in the provisionally elected Group 1, each of claims 1-14 and 17 read on both the species of FIGURES 1 and 4. Thus, claims 1-14 and 17 are generic to Species 1 and 2.

Applicant respectfully submits that the restriction as between the species of FIGURES 1 and 4 should be withdrawn. 37 C.F.R. 1.141 provides that a reasonable number of species may still be claimed in one application if the other conditions of the rule are met, including that “the application also includes an allowable claim generic to all the claimed species.” As discussed above, claims 1-14 and 17 are generic. Thus, upon one of these or any other generic claim being

determined as allowable, Applicant respectfully submits that the restriction as between the two species should be withdrawn because two species is believed to be a reasonable number of species.

Conclusion

In view of the above, Applicant respectfully traverses the August 29, 2005 Restriction Requirement, as well as the modified restriction requirement of the December 13, 2005 Office Action as being improper. A prima facie case for requiring such a restriction has not been established by the Examiner. Therefore, Applicant respectfully petitions the Director to reconsider and withdraw the outstanding restriction requirement for the reasons discussed above.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 49581/P042US/10315832 from which the undersigned is authorized to draw.

Date: February 1, 2006

Respectfully submitted,

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Application No. (if known): 10/807,789

Attorney Docket No.: 49581/P042US/10315832

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